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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,118	11/19/2003	Kevin Krietemeyer	12406/79	9903

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EXAMINER	
FERNSTROM, KURT	
ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

5P

Office Action Summary	Application No.	Applicant(s)	
	10/718,118	KRIETEMEYER, KEVIN	
	Examiner	Art Unit	
	Kurt Fernstrom	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-23 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claim 21, there is specification does not disclose that the number of picks is determined by filling out at most one box. Rather, as shown in Figure 2B, two boxes are filled out. With respect to claim 26, there is no disclosure in the specification that all of the games recited in claim 6 are simultaneously played.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8-10, 13, 16, 17, 20, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Jarvis. Jarvis discloses in Figures 1 and 2 and in column 2, line 24 to column 3, line 18 of the specification a method and device of playing a lottery comprising a gaming slip 12 comprising a substrate having gaming information printed thereon, including a random request region 26 that enables a plurality of computer-generated picks to be requested in conjunction with a lottery. Column 3, lines 3-17 in particular discusses the use of a computer to generate picks when a random request is received. With respect to claims 3 and 13, column 3, lines 3-17 further discusses the selection of six numbers when a random request is received. With respect to claims 4 and 8, Jarvis discloses that a manual selection region 14 including one or more manually selected numbers is provided which enables a manual pick to be made. With respect to claim 5, Jarvis discloses that a draw request region 22 is provided which enables picks to be played for a plurality of drawings. With respect to claims 17 and 20, a machine readable medium as claimed is inherent in the disclosure of Jarvis, in particular that portion which discusses the use of a computer to generate random numbers in response to a random request. It should also be noted that claim 17 recites a machine readable medium **to store** a set of instructions. By reciting the invention as an intended purpose, rather than a positive limitation, in strict terms any computer readable medium reads on claim 17, and thus claims 18-20, as written.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 6, 7, 11, 12, 14, 15, 18, 19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis in view of Mullins. Jarvis discloses all of the limitations of the claims with the exception of the different types of games provided on the gaming slip. Providing a single gaming slip with multiple types of games thereon is known, as disclosed for example by Figures 1-3 of Mullins. It would have been obvious to one of ordinary skill in the relevant art to modify the method and device of Jarvis by providing different types of games on the slip for the purpose of allowing a user to easily participate in the different games, particularly given that Jarvis discloses a plurality of random request regions and manual request regions on its gaming slip. With respect to claims 15 and 19, tracking gaming data is inherent in the method of Jarvis, given that a computer is used to generate and store random numbers in response to a random request. Storing such numbers amounts to tracking the numbers, and thus game data. It should be noted with respect to these claims that "track" and "based on each type of game played" are both instances of very broad claim language, and have been examined under their broadest reasonable interpretation.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jarvis. Jarvis discloses all of the limitations of the claim with the exception of the gaming slip being a piece of paper. Rather, Jarvis is silent as to the material used for the ticket.

However, Official Notice is taken that paper is an extremely well known type of material to use for gaming slips, and would have been an obvious means to allow a user to request numbers which can then be fed into and processed by a computer.

Response to Arguments

Applicant's arguments filed on October 26, 2004 have been fully considered but they are not persuasive. With respect to the arguments concerning a plurality of picks, Jarvis discloses a plurality of "easy pick" and "quick pick" boxes on the substrate in Figures 1 and 2, respectively. The random request region of Jarvis is not a single box, bu a plurality of boxes. The plurality of picks generated by the gaming slip can be seen in Figure 3. Column 3, lines 8-11 of Jarvis actually discloses a game ticket "issued for five games... and the six selected numbers for **each set** of numbers used in each game was randomly picked by the computer (emphasis added). Thus, Jarvis discloses a random request region that enables a plurality of picks to be made, where each pick comprises a plurality of numbers.

Clarification on the correlation between claim 4 and the playing of picks for a plurality of drawings has been provided above. Namely, "claim 5" has been substituted for "claim 4" in the pertinent discussion, to correct a typographical error.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mullin discloses in column 1, lines 51-60 the drawbacks of gaming tickets which allow only one game to be played, thus suggesting the desirability of a single ticket which allows more than one game to be played. The prior art, viewed as a whole, suggests the claimed invention.

In response to the arguments concerning claims 15 and 19, the phrase "based upon the types of games played" remains extremely broad. The computer of Jarvis inherently tracks the numbers it generates, thus tracking game data based on the lottery-type game being played. While it is apparent from the specification that applicant is contemplating a different type of tracking than this, the claims as written fail to overcome the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
January 19, 2005

URT FERNSTROM
IMARY EXAMINER